

## **REMARKS**

### **A. The 101 Rejections Are Moot**

The section 101 rejection is moot because the rejected claims have been canceled.

### **B. The Rejection of Claim 35 and Its Dependents Is Moot**

The indefiniteness rejection is moot because claim 35 and its dependents have been canceled; they include all the limitations of claim 15 and are therefore not needed. Applicants do not acquiesce that the claims were indefinite because they included the phrase “may be.” The case of *In re Venezia*, 530 F.2d 956 (CCPA 1976) explains why. In that case, the Board affirmed an examiner’s indefiniteness rejection of several claims that included the phrase “may be” on grounds that the claims were “directed to an assembly to take place in the future. No present positive structural relationships are recited.” *Id.* at 958. The Federal Circuit’s predecessor court reversed, and specifically addressed the fact that one of the claims included the criticized language “may be slideably positioned.” *Id.* at 958-59. The court explained that this and similar language “defines present structures or attributes of the part of the ‘kit’ identified as the housing, which limits the structure of the housing to those configurations which allow for the completed connector assembly desired[.]” and found “nothing wrong” with the language. *Id.* (emphasis added).

### **C. The Anticipation Rejections of Claims 1 and 38 Are Overcome**

Claim 1 has been amended to incorporate the “fiber” limitation of claim 2 in order to distinguish Cox and the asserted Cox-Peters combination. The Office admits that Cox fails to disclose a fiber, but asserts that Peters cures this deficiency. However, while Peters discloses a fiber that is butt-coupled to an array of VCSELs, Peters fails to teach or suggest *fabricating* one or more of the VCSELs on the endface of the fiber. As Dr. Magnusson explains in the attached

declaration, the claim language “fabricated on the endface of the at least one fiber” does not encompass the butt-coupled relationship between fiber 84 and the VCSEL array disclosed in Peters. Second Magnusson Declaration at ¶¶ 3 and 4. Thus, the asserted combination lacks the claim limitation of a guided-mode resonance waveguide *grating fabricated* on the endface of a fiber, and the rejection should be withdrawn. To the extent the Office relies on the Magnusson patent in its rejection of examined claim 2, the Magnusson patent does not cure this deficiency. Claim 38 has been amended in the same way as claim 1, and it is patentable for the same reason as claim 1.

**D. The Obviousness Rejections of the Claims that Depend from Claims 1 and 38 Are Overcome**

All of the claims that depend from claims 1 and 38 are patentable over all the asserted combinations for at least the same reason that claim 1 is patentable. None of the additional art cited against these dependent claims cures the deficiency identified above.

**E. The Obviousness Rejections of Claim 15 and Its Dependent Claims Are Overcome**

Claim 15 has been amended in the same way as claim 1, and it is patentable over the asserted combination for the same reason as claim 1, as are the rejected claims that depend from claim 15. None of the additional art cited against those dependent claims cures the deficiency identified above.

**F. Conclusion**

Applicants respectfully submit that claims 1, 4-12, 14-20, 24-34, 38-51, 61 and 62 are in condition for allowance. Should the examiner have any questions, comments, or suggestions relating to this application, he **and Supervisory Examiner Glick** are invited to contact the undersigned attorney at (512) 536-3031 in an effort to narrow any perceived patentability issues and advance prosecution as quickly as possible.

Respectfully submitted,

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